

**IN THE DRAWINGS**

**Please add new FIG. 12 as indicated in the attached new sheet drawing.**

## **REMARKS**

### **Response to Objection to Drawings**

The drawings were objected to under 37 C.F.R. §1.83(a). The Examiner noted that the drawings must show every feature of the invention specified in the claims. In response to this objection, Applicants have added new FIG. 12 which is FIG. 4 from U.S. Pat. No. 6,344,026 (Serial No. 09/208,535) which was incorporated into the present application by reference (see page 6, lines 17-32 of the present application). The newly added FIG. 12 differs from FIG. 4 of the '026 patent by the addition of tissue damaging elements 428 and new reference numbers which are clearly shown in FIGS. 1-3 of the present application. No new matter is introduced by this amendment. The cited portion of the present application above clearly supports the addition of tissue damaging members to the devices described in the '026 patent.

### **Response to Claim Rejections Under 35 U.S.C. §112**

Claims 19, 20, and 25-39 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. However, the new FIG. 12 which was taken from the '026 patent shows the three elements namely tissue cutter, tissue damager and encapsulation member. The disclosure for all three elements is clearly supported throughout the specification and particularly page 6, lines 17-32 of the present application.

### **Response to Claim Rejections Under 35 U.S.C. §102**

Claims 1 and 22-24 were rejected by the Examiner under 35 U.S.C. §102(b) or 102(e) as being anticipated by Kresch et al. (U.S. Pat. No. 5,527,331), Savage et al. (U.S. Pat. No. 6,032,673) and Burbank et al. (U.S. Pat. No. 6,344,026). However, none

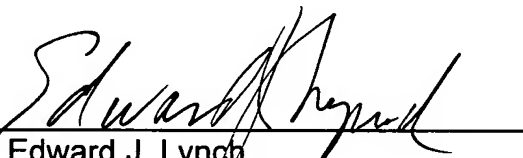
of these references describe all of the features of claim 1 as amended above. For example, Kresch ('331 patent) and Savage (673 patent) have an electrosurgical wire that is oriented transverse to the longitudinal axis and therefore does not extend along a length of the operational portion and the tissue morcellation member is not located within the length of the operational portion as called for by claim 1. Burbank et al. (026) discloses tissue separation and encapsulation but fails to teach tissue separation with a separate tissue damaging while the tissue remains at the tissue cutting location.

In as much as the cited references do not teach every feature of claim 1, these references cannot anticipate the invention claimed in claim 1 or those claims which depend from claim 1.

#### **Conclusion**

Applicants believe that the presently pending claims are adequately supported by the specification and are directed to patentable subject matter. Further consideration pursuant to the concurrently filed RCE and an early allowance of these claims are earnestly solicited.

Respectfully submitted,

By:   
Edward J. Lynch  
Attorney for Applicants  
Registration No. 24,422

**DUANE MORRIS LLP**  
One Market  
Spear Tower, Suite 2000  
San Francisco, CA 94105  
Telephone: (415) 957-3000  
Facsimile: (415) 957-3001  
**Direct Dial: (415) 957-3067**